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Current DOE TT & IP Issues



- The rest of the story.
- This year's stories.
- Heads up.

The rest of the story: Lab A



- Lab A competing with the private sector:
 - Using equipment in CRADA where partner brings commercial samples to lab for action. CRADA partner competes with private firm for same work. Lab employee gave joint technical presentations with CRADA partner, stood at display booth and accompanied partner to potential customer sites.

The rest of the story: Lab A



■ DOE analysis

- Action on samples done to see if process works not commercial activity
- Employee conduct left to lab to address
- Suggestion to TPWG that labs think about code of conduct

The rest of the story: Lab B



- Lab B licensed technical data produced at lab as though it were a lab trade secret without DOE approval.
- DOE analysis and action
 - IG report
 - Study of whether labs should have the right to license technical data.

The rest of the story



- Grant Backs
- DOE reaction: Consult with labs and develop guidance which sets a line. Labs free to act on the right side of the line.

This Year's Stories



■ Lab C

- TT specialist assigned to negotiate a CRADA which would combine lab technology “Good Stuff” with partner technology.
- Non-disclosure agreements with data being shared.
- TT specialist advises lab that specialist and PI are interested in licensing lab technology.

This Year's story: Lab C



■ LAB C actions

- TT specialist per lab policy removed from handling CRADA. PI replaced as PI.
- To assure fairness of opportunity lab issued CBD announcement
- TT office notified lab conflict of interest office
- Lab sent letter to partner advising partner of actions taken
- Lab revised policies: tt specialist may not obtain license on any technology where TT specialist involved in tt negotiations. Considering need for policy re PI's. Issue: exposure to prop data.

This Year's story



- Lab D has new clean up technology with associated equipment developed by EM.
- No partner interest found.
- SB environment company "T" approached about partnering
- Lab contractor and T form LLC called "Y"

This Year's story: Lab D



- Lab contractor takes substantial equity interest in Y. Lab employee appointed to Bd. Of Directors. Other lab employees join Y on entre. leave. Employees advised of lab conflicts policy.
- Lab D contractor grants exclusive license to Y. Not approved by DOE. License does not require Y to obtain its own equipment.
- DOE approves CRADA between Lab D and Y. Y allowed to use equipment on noninterference basis. Lab employee to control use of equipment. DOE does not require any special COI procedures.

This Year's story: Lab D



- Y has problems.
- Deployment of equipment issues: complaints that equipment not available to government.
- Very unhappy DOE program.

This Year's story: Lab D



- UC policy says UC won't take more than 10% equity, bars UC employees from being on Bd.
- Why take equity interest in company that will be working mostly for the Government?
- DOE employee in control of equipment
- Should DOE have assumed control of all licensing decisions as condition for approving CRADA?

This Year's story



- Jt. Research involving lab employee and Lab contractor employee (the “guest”) who is not employed at lab.
- Guest spends 6 months at DOE lab and then goes back to guest’s usual place of business. Lab Contractor files patent application on new invention reported by guest. Guest says invention made after stay at DOE lab.
- DOE Lab employee-collaborator claims to have made same invention. Claims guest’s invention was stolen from collaborator.

This Year's story: the guest



- Who decides proper inventorship? Lab contractor, DOE?
- Can ADR help?

Heads Up



■ Homeland Security

- Lab as technology developer
- Lab as Technology evaluator, advisor
- Example: NRC codes that are relied on to evaluate commercial reactor safety were developed by a DOE lab. Foreign commercial market and spin-off market. Lab licenses code. NRC used lab as technical advisor. NRC very unhappy.

Heads Up: Software dissemination choices



- As scientific information, uncopyrighted, freely available for all to use, duplicate, make derivative works , and further distribute,etc.
- As copyrighted software available under a restrictive, royalty bearing license (i.e. tech transfer subject to licensing rules).
- As open source software.

Heads Up: Software dissemination choices



- Who chooses?
- What does your program want?

Heads Up:



- Other Transactions authority